

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte YASMIN THANAVALA

Application No. 09/464,414

MAILED

JAN 13 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

### ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 28, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

First, the section "References of Record" is missing from the Examiner's Answer dated 1/14/2004. See Manual of Patent Examining Procedure (MPEP) § 1208 (8<sup>th</sup> ed., August 2001) p. 1200-18-19. Appropriate correction is required.

Second, the Examiner's Answer discusses the following references in the Grounds of Rejection and the Response to Argument.

Bratu et al. (Expert Opinion Biological Therapy, 2002, 2(2):187-95, Active immunization against human tick-borne diseases, under "4. Rocky Mountain spotted fever immunization")

Titball et al. (Vaccine, 2001, 12(20):4175-84. Vaccination against bubonic and pneumonic plague)

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Genetically Modified Vaccines: Vaccines by Design" (Current Pharmaceutical Biotechnology, 2001, 2:47-76)

Farci et al. (Science, 1992, 258: 135-140. Lack of Protective Immunity Against Reinfection with Hepatitis C Virus")

U.S. Patent No. 5,679,880

U.S. Patent No. 5,686,079

U.S. Patent No. 5,654,184

U.S. Patent No. 6,136,320

U.S. Patent No. 5,914,123

If the Examiner relies on these references to maintain the rejection, they should be cited in the "Prior Art of Record" section in the Examiner's Answer.

Third, It is not apparent from the record that the examiner properly considered the Information Disclosure Statement dated 12/16/2002, nor notified appellant why his submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

Accordingly, it is

**ORDERED** that the application is electronically returned to the Examiner to

- (1) submit a Supplemental Examiner's Answer including the missing title as required by MPEP § 1028 as well as the references relied on in the Prior Art of Record section;
- (2) consider the IDS as set forth in 37 CFR §§ 1.97 and 1.98;
- (3) written notification to appellant as to consideration; and
- (4) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
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